

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/487,729
Attorney Docket No. Q57577

REMARKS

I. Introduction

The present application has been withdrawn from appeal and the Examiner has reopened prosecution by issuing a non-final Office Action. In the Office Action, pending claims 1, 3-5 and 7-8 have been examined and are rejected. Specifically, claims 1 and 5 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,344,882 to Shim et al. (hereinafter "Shim"). Claims 3-4 and 7-8 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shim in view of newly applied U.S. Patent No. 5,969,769 to Hamadate (hereinafter "Hamadate"). By way of overview, Applicant traverses the rejections of claims 1, 3-5 and 7-8 as follows.

II. Summary of Examiner Interview

Because the Examiner previously rejected claim 1 under 35 U.S.C. § 102(e) as allegedly being anticipated Shim (*see* Office Action dated August 28, 2002), wherein the rejection was subsequently withdrawn, Applicant's representative conducted a telephone interview with Examiner P. Natnael on June 18, 2004 to request an explanation as to why the Examiner is again applying this reference, in particular given that the scope of claims 1 and 5 are now narrower than when the Examiner's initial application of Shim was traversed.

During the interview, Applicant's representative discussed claim 1, as an exemplary claim, in explaining the operation of various illustrative embodiments of the claimed invention.

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Applicant's representative also pointed out that the Applicant had already successfully distinguished Shim from the claimed invention once before (*citing* Applicant's Response Under 37 C.F.R. § 1.111 filed on November 20, 2002).

Furthermore, Applicant's representative again distinguished the claimed invention from Shim, as well as newly applied Hamadate, for Examiner Natnael's benefit. Based on the discussions between the Examiner and Applicant's representative, the Examiner agreed to reconsider his reliance on Shim and Hamadate, upon Applicant's filing of a response to the non-final Office Action.

III. Claim Rejections -- 35 U.S.C. § 102(e)

As noted above, claims 1 and 5 stand rejected under § 102(e) as allegedly being anticipated by Shim. The Examiner's rejection of claim 1 (and more recently added claim 5) is essentially the same as that set forth in the Office Action dated August 28, 2002. It is respectfully submitted that Shim fails to disclose each and every feature recited in claim 1 (and claim 5).

For example, claim 1 recites a unique combination of features including, *inter alia*, a controller for receiving the channel number output from the key input and storing the channel number output from the key input in the memory while controlling the tuner to tune to a broadcasting channel corresponding to the received channel number. In the Office Action, the Examiner alleges that the controller of claim 1 is met by microcomputer 18, as shown in Fig. 6 of Shim (Office Action: page 3).

To the contrary, the microcomputer 18 does not store channel numbers output from a key input. Instead, Shim discloses that the microcomputer 18 stores channel numbers based on an automatic channel scanning process (Shim: col. 7, lines 4-34; and Fig. 10). In this regard, Shim is not substantially different from the prior art described on page 1 of Applicant's specification. Furthermore, the aspect of Shim that describes individually tuning a specific channel in response to a user's key input (*see, e.g.*, Shim: col. 9, lines 1-35; and Fig. 11) does not disclose storing the channel information.

Applicant's claim 1 further recites that "the controller receives a signal output from the signal processor, determines whether a broadcasting signal is present in the currently tuned broadcasting channel and stores the corresponding broadcasting channel number in the memory only if said broadcasting signal is present." In the Office Action, the Examiner alleges that these features of claim 1 are met by the disclosure of Shim (*see* Shim: col. 6, lines 44-49) that a synchronization detection unit 15 detects the synchronization signals output from the intermediate frequency signal processing unit 12 in order to discriminate whether there exists any broadcast signals at the time of channel switching and supplies them to the microcomputer 18 (Office Action: page 3).

The Examiner also cites the disclosure of Shim (*see* Shim: col. 6, lines 53-58) in alleging that the microcomputer 18 discriminates whether there exists any broadcast signals on the pertinent channel on the basis of the IF AGC supplied from the intermediate frequency signal processing unit 12 through the level shifter 22 and, if a broadcast signal is discriminated, then the microcomputer 18 stores such channel data in memory 17 (Office Action: page 4).

The portions of Shim relied on by the Examiner, however, relate to an *automatic channel scan* and not to a user using a key input to input a channel number according to the user's selection. This is evident from the sentence immediately preceding the second portion of Shim cited by the Examiner: "Microcomputer 18 outputs a series of tuning data from the automatic channel storage mode to tuner 11 and drives simultaneously the speed-up drive units 19 and 20 for high speed tuning." (Shim: col. 6, lines 50-53). Thus, because the microcomputer 18 outputs a *series* of tuning data, the portions of Shim relied on by the Examiner do not relate to a situation in which a user enters a channel number via a key input, but rather that these portions relate to an automatic frequency scan.

In view of the above-described differences between Shim and the invention as defined in claim 1, Shim does not anticipate, or otherwise render obvious, the subject matter of claim 1. Claim 5 recites features similar to those found in claim 1 and, thus, claim 5 is not anticipated by Shim based on a rationale analogous to that set forth above for claim 1.

IV. Claim Rejections -- 35 U.S.C. § 103(a)

Claims 3-4 and 7-8 stand rejected under § 103(a) as allegedly being unpatentable over Shim in view of Hamadate. It is respectfully submitted that Hamadate fails to cure the exemplary deficiencies of Shim, as described above for claim 1 (and claim 5). Consequently, claims 3-4 and 7-8 are patentable over the Examiner's proposed combination of Shim and Hamadate at least by virtue of their dependency.

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V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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Date: July 19, 2004